

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated February 7, 2003, indicated that claims 1, 2, 5-9 and 12-16 stand rejected under §103(a) as being anticipated by *Kagami et al.* (U.S. Pat. No. 5,974,400) and further in view of *Graf et al.* (U.S. Pat. No. 6,349,300); and claims 3, 4, 10 and 11 stand rejected under §103(a) as being unpatentable over *Graf et al.* in view of *Kagami et al.*

Applicant respectfully traverses each of the §103(a) rejections and maintains that the asserted combination of references fails to correspond to the claimed invention. The current Office Action merely repeats the previous rejections and arguments with a few added citations that are inapplicable to the claimed invention including, *e.g.*, a computer-driven web-linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match.

As discussed previously, claim 1 of the instant invention is directed to on-line viewing of an article on a structure including, *inter alia*, a computer-driven web-linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match. The Office Action acknowledges at page 3 that the '400 reference fails to teach comparison of color codes identifying respective colors of such related objects. The Office Action then attempts to overcome this deficiency by alleging that the '300 reference teaches the comparison of color codes. But neither reference, alone or in combination with the other, teaches the comparison of color codes for two similarly colored products or, of even comparing two colored products. Rather, the proposed combination merely teaches matching one colored product to a standard color code. Without such correspondence, the §103 rejections cannot be maintained, and Applicant requests that the rejections be withdrawn.

The Examiner indicated in his Response to Remarks section on page 2 that "a further detailed breakdown of reference locations of operative terms in the claims is provided in bold letters." Applicant assumes that these citations are from the main '400 reference except where Applicant's Specification is noted. In fact, the bolded portions of the Office Action are four new citations repeated throughout, none of which teach a computer-driven web-

linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match.

The cited portion at Col. 5, lines 52-60 of the '400 reference indicates that the '400 teachings are directed to a "try on" service administered over cable television where appearance and comfortness of an item are confirmed. The citation fails to provide any new correspondence between the '400 reference and the claimed invention and does not help to show a computer-driven web-linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match.

Next, item 705 of Figures 7 and 8 is cited, but item 705 merely shows the available colors for one given item. Item 705 was cited in previous Office Actions and provides no new correspondence to the '400 reference. The new citation of item 705 fails to show the missing correspondence of a computer-driven web-linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match.

The portion cited at Col. 6, lines 5-10 also fails to provide any new correspondence to the claimed invention. This portion addresses one article being drawn on a 3D figure including a color operation. These teachings of the '400 reference fail to address a computer-driven web-linking engine for using a color matching criterion to compare a colored structure with a similarly colored article to determine whether the two colors match.

The Office Action also erroneously attempts to use Applicant's Specification as an admission. The cited portion of the Specification merely points out industry color-standardization schemes that may be used in specific embodiments of the invention. The citation fails to provide any new correspondence to the '400 teachings. The Office Action attempts to use Applicant's Specification for correspondence to "computer-driven web-linking engine compares by using a data set that includes a frequency-based color identification code provided for the color of the article and a frequency-based color identification code provide for the color of the structure." Therefore the Office Action's citation to the Specification is in applicable and does not help to show correspondence between the '400 reference and the claimed invention.

Applicant further submits that the Office Action fails to present evidence of motivation in support of the modification of the '400 reference with the '300 reference. Evidence has not been provided of any teaching or suggestion for using the '400 reference in connection with viewing more than one item and comparing the respective color codes of two products, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d (Fed. Cir. 2000). The Office Action fails to identify any evidence of why one skilled in the art would be led to modify the '400 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Neither the '400 or the '300 reference addresses using a color criterion for comparing color codes of two colored items. Applicant requests that the rejections be withdrawn.

Moreover, the §103 rejections are improper because the proposed modification would undermine the purpose and operation of the '400 reference. The '400 reference is directed to addressing a need for passing personal preferences, where a high degree of secrecy is essential. *See*, col. 6, lines 42-44. In order to address this need, the '400 reference teaches allowing the client to enter personal data encoded to shield the content from a server where the content is passed through a server to an expert. The expert then issues an opinion that is returned to the client for evaluation. The '400 server intentionally does not provide any evaluation or comparison because it does not have rights to access the client's personal preference data. Rather, the server acts merely as a conduit for the expert.

The Office Action asserts that only face and body shape are shielded from the server while the color attributes are visible in the screens shown in Figures 7 and 8. The color attributes of the '400 reference are coupled with the face and body shape since the "try-on" information is sent to the expert in order to initiate an opinion. Hence, any level of secrecy

afforded the face and body shape is also afforded to the color attributes and all of this information is hidden from the server. Therefore, the server cannot perform any comparison or evaluation as claimed by Applicant.

The Office Action proposes modifying the '400 reference such that the color comparison technique of the '300 reference is performed by the server. This server-related function would require that the server have access to the client's personal preference data. Such access is in direct opposition to the purpose of the '400 reference. Because this modification would require the server to read the client data in order to make the comparison, this modification would directly undermine the essential secrecy of the client's data as taught by the '400 reference. To allege under §103 that a skilled artisan would modify the '400 reference in such a manner is untenable and impermissible under §103. *See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)* (A §103 rejection cannot be maintained when the asserted modification undermines the purpose of the main reference.)

Further, to modify the '400 reference by inserting the color comparison technique of the '300 reference, the '400 reference would not function as alleged, for example, in Figures 7 and 8. As discussed above, the color comparison of the '300 reference would match a selected color (e.g., white) with a color standard for white, thereby replacing the left portion of the screen illustrated in Figures 7 and 8. Thus, the proposed modification would not only undermine the purpose, but also undermine the operation of the '400 reference. *See, e.g., In re Gordon.*

Moreover, the Office Action continues to cite an inapplicable patent office decision as a substitute for evidence of motivation. Unlike the claimed invention, the cited decision involved an instance of duplication of parts. In accordance with the above discussion regarding the lack of correspondence between the claimed invention and the cited references, the issue here is not duplication of parts but, rather, lack of correspondence. In regards to the claimed invention, Applicant fails to see which parts are allegedly duplicated. The facts in the cited case are not sufficiently similar to the instant application. *See, M.P.E.P. §2144.* Because the Examiner has not presented any relationship between the allegation of duplication and the claimed invention, this Office Action citation is irrelevant and inapplicable.

The Office Action still fails to respond to Applicant's previous arguments presented in the Office Action Response filed on September 24, 2002 and the Office Action Response filed on January 27, 2003. The Office Action does not address Applicant's arguments with respect to the impropriety of the proposed combination. The Office Action fails to present specific evidence of where the '400 reference teaches the limitations of the claimed invention, in claim 1, for example, the colored article, colored structure, and item. Also, the Office Action provides no response to Applicant's arguments regarding how the proposed modification would undermine the operation of the '400 teachings. M.P.E.P. 707.07(f) dictates that the Office Action should take note of the Applicant's arguments regarding the impropriety of the cited references and the asserted combination and answer the substance of them. This is consistent with the purpose of aiding the Applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. §1.104(a)(2). Evidence of complete correspondence has not been presented in support of the Examiner's proposed combination. The Office Action does not comply with this requirement, and Applicant requests that the §103 rejections be withdrawn.

New claims 17-22 merely manifest Applicant's "long-accepted right to press alternative claims covering different aspects of ... [Applicant's disclosed] invention." *Amgen, Inc. v. Hoechst Marion Roussel*, 126 F. Supp.2d 69 (D. Mass. 2001). Support for these new claims may be found at page 5, lines 17-25 and in Figure 1, the sellers 114. No new matter is introduced in these new claims. Applicant respectfully submits that, by way of this Office Action Response, there is no intention to narrow, nor has the Applicant narrowed, the breadth of the claims as originally filed through the explanatory comments provided herein.

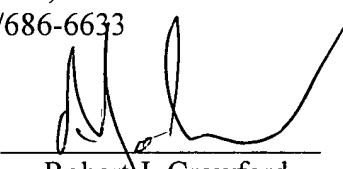
Please charge Deposit Account No. 50-0996 (JARB.004PA) in the amount of \$60.00 for the new independent claim beyond three and the two new claims beyond twenty for a SMALL ENTITY and charge/credit the same Deposit Account No. for any deficiency/surplus.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120

651/686-6633

By: 

Robert J. Crawford  
Reg. No. 32,122

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